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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,665	06/28/2001	Carlos F. Barbas	8098-005-US-1	2213
32301 7590 10/10/2007 CATALYST LAW GROUP, APC 9710 SCRANTON ROAD, SUITE S-170 SAN DIEGO, CA 92121			EXAMINER CARLSON, KAREN C	
			ART UNIT 1656	PAPER NUMBER
			MAIL DATE 10/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/807,665

**Applicant(s)**

BARBAS, CARLOS F.

**Examiner**

Karen Cochrane Carlson, Ph.D.

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The Office Action is in response to the paper filed September 12, 2007.

Claims 22-50 have been cancelled. Claim 1 is currently under examination.

Priority is set to **October 16, 1998**.

#### **Withdrawal of Rejections:**

The rejection of Claim 1 under 35 U.S.C. 112, second paragraph, is withdrawn.

The rejection of Claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn.

#### **Maintenance of Rejections**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 1 is again rejected under 35 U.S.C. 102(e) as being anticipated by Barbas et al. (USP 6,242,568, issued June 5, 2001 and having a 102(e) date of December 30, 1996).

Barbas et al. teach C7 zinc finger nucleotide binding polypeptide containing instant SEQ ID NO: 41 (KSADLKR) in Figure 15 and in patent SEQ ID NO: 42 at amino acids 20-26 (Claim 1).

USP 6,140,466 (priority to at least May 27, 1997) is the same up through Example 13 of USP 6,242,568 and would be applied in the same manner as 6,242,568.

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This rejection is being maintained because the Examiner has been examining the phrase "...such that the nucleotide binding activity of the polypeptide resides in the nucleotide binding region having the sequence SEQ ID NO: 41..." by the second interpretation, ie, that is it intended that the binding of SEQ ID NO: 41 to the nucleotide molecule must be one of several nucleotide binding regions that bind to the nucleotide molecule, and the activity is transcription resulting from the collective binding of the nucleotide binding regions (in which at least one must be SEQ ID NO: 41).

This interpretation was confirmed in the instant response at page 6, para. 5.

Applicants' arguments begin on page 6-10 of the reply filed September 12, 2007.

Applicants again argue that '568 does not establish that the nucleotide binding activity of the polypeptide C7 resides in the nucleotide binding region having SEQ ID NO: 41, or that SEQ ID NO: 41 would bind nucleotides GAG, GTG, GCT, and GCC. Rather, '568 demonstrates that SEQ ID NO: 41 binds nucleotide GCG. In response, the designation of a new function for a known region does not change the fact that the region is part of the C7 polypeptide. Because structure and function are related, one would conclude that that region of C7 that comprises SEQ ID NO: 41 will bind to nucleotides GAG, GTG, GCT, and GCC, even if were Applicants that made this observation.

Applicants urge (page 11-12) that the phrase "consisting essentially of" limits the claim in scope. This phrase is used generally for desperate objects, such as a pharmaceutical composition consisting essentially of Drug X and a carrier. Thus, stabilizers, preservatives, and other agents used in pharmaceuticals that are in the composition not as the drug but for the

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benefit of the drug preservation or ease of injection are given no patentable weight. In the instant situation, "consisting essentially of" is the same as "comprising" or "having".

At page 13, Applicants urge that the existence of other nucleotide binding regions in the polypeptide of Figure 15 of Barbas et al. '568 does affect the basic and novel characteristics of the claimed invention because the activity of this polypeptide resides in the specific binding of nucleotide sequences. Rather, Barbas et al. teach that the claimed SEQ ID NO: 41 is a nucleotide binding region that binds triplet GCG (and not GCT, GCC, GAC, or GTG as set forth in Fig 1). Applicants conclude that the zinc finger nucleotide binding polypeptide of Barbas et al. is structurally and functionally different from the claimed zinc finger nucleotide binding polypeptide. The Examiner has reviewed Barbas et al. and does not find the passage that teaches that instant SEQ ID NO: 41 binds to any triplet. Please explain further.

The Claim as written fails to read over '568. Thus, this rejection is maintained.

No Claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946.

The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Kathleen Kerr Bragdon can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER**